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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,722	11/01/2000	Shigeyuki Sudo	58799-029	9518

7590 06/29/2004  
McDermott, Will & Emery  
600, 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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BLOUNT, STEVEN

ART UNIT	PAPER NUMBER
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2661

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DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/702,722

**Applicant(s)**

SUDO ET AL.

**Examiner**

Steven Blount

**Art Unit**

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 8,15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 8 and 15 are objected to because of the following informalities: in claims 8 and 15, line 2, the comma should be replaced with a colon. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 7 and 15 are rejected under 35 U.S.C. 112 second paragraph for failing to particularly point out and distinctly claim the subject matter which the applicant regards as their invention.

In claim 1, line 4, “detecting a result of the registration” is indefinite, as the registration is not attempted in any of the preceding steps (even though “controlling registration” is mentioned in the preamble). Perhaps it would be better to say “detecting the result of a registration.”

In claim 15, lines 10+ are grammatically indefinite.

5. Claims 1 – 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In each of the independent claims (see, for example, claim 1, lines 6 – 7), applicant has claimed retrying registration after “inhibiting switching to a good pilot signal” (ie, after handoff is inhibited). However, in the specification, handoff is inhibited only after the process of attempting to register has ended (ie, after the given number *n* *p14, start* has been reached). See also page 21, lines 6+ of the specification. *p15, l16* *of 2nd Par.*

***Claim Rejections - 35 USC § 103***

6. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants admitted prior art (hereinafter AAPA) in view U.S. patent 6,292,508 to Hong et al.

With regard to claim 12, AAPA teaches a CDMA communication system wherein mobile units despread signals (p1, 2<sup>nd</sup> paragraph) sent to them from a base station, and also acquire pilot signals (page 2, lines 1+). AAPA, beginning on page 3, lines 1+, also discusses the problem associated with having registration done repeatedly putting a drain on the battery and increasing network traffic. AAPA does not, however, teach turning off the receiver after repeated registration attempts. The process of turning off a receiver after repeated signaling/scanning is taught in Hong et al in col 21 lines 25+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have turned off the receiver of AAPA after repeated registration attempts, in light of the teachings of Hong et al, in order to conserve battery power.

With regard to claim 15, see the above, and additionally note that on page 2, third to last line of the specification, it is stated that pilot signals are acquired and their strengths measured, and that after synchronization, the registration process is carried out (see page 3, lines 1+). Note also that failure is a condition to the receiver being turned off in the above two mentioned patents.

7. Claims 12 – 15 are rejected under 35 U.S.C. 103(a) as being obvious over applicants admitted prior art (AAPA) in view of U.S. patent 6,263,200 to Fujimoto.

With regard to claims 12 and 15, AAPA teaches a CDMA communication system wherein mobile units despread signals (p1, 2<sup>nd</sup> paragraph) sent to them from a base station, and also acquire pilot signals (page 2, lines 1+). AAPA, beginning on page 3, lines 1+, also discusses the problem associated with having registration done repeatedly putting a drain on the battery and increasing network traffic. AAPA does not, however, teach turning off the receiver after repeated registration attempts. The process of turning off a receiver after repeated signaling/scanning is taught in Fujimoto in col 11, lines 15+.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have turned off the receiver of AAPA after repeated registration attempts, in light of the teachings of Fujimoto, in order to conserve battery power.

With regard to claims 13 and 14, see columns 20 and 21 of Fujimoto, where threshold is discussed.

8. Claims 1 – 11 are currently allowable over the prior art of record, though the 112 rejections remain.

Art Unit: 2661

***Response to Arguments***

9. The applicants remarks have been considered. The examiner notes that Fujimoto teaches a battery power conservation method directed to wireless systems generally, while Hong et al discusses the invention in the context of a frequency hopping system, as described in the abstract.

10. Steven Blount may be reached at 703 – 305 – 0319 between the hours of 9:00 and 5:30 Monday through Friday.

  
**Ajit Patel**  
**Primary Examiner**

SB



6/21/04